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EXAMINER

NGUYEN, LUONG TRUNG

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YUTAKA NAKATSU, SHIN IIMA, KAYOKO OHYOSHI, and
TOMOMI NAKAMURA

Appeal 2007-3585
Application 08/610,758
Technology Center 2600

Decided: April 22, 2008

Before JOSEPH F. RUGGIERO, JOHN A. JEFFERY, and KEVIN F.
TURNER, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 8-26, 28-38, and 40-71. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was conducted on this appeal on April 10, 2008.

We affirm.

Appellants' claimed invention relates to a video printer in which a video camera having a liquid-crystal display monitor is electrically coupled and detachably connected to the video printer housing. An operating system is disposed on the front upper surface of the video printer housing enabling a user to operate the video camera and the video printer from the operating system. (Specification 2-4).

Claim 8 is illustrative of the invention and reads as follows:

8. A printer comprising:

a printer housing portion, a printer mechanism and an operation system;

said printer housing portion having a connector, said connector mechanically and electrically attaching a camera to said printer housing portion;

said camera being removably connectable with said printer housing portion, said camera being adapted to operate separate and apart from said printer, a display device being incorporated within said camera;

said printer mechanism being incorporated within said printer housing portion, an image being captured by said camera; and

said operation system being incorporated within said printer housing portion, said operation system controlling said camera to select said image for exhibition on said display device as a displayed image, said operation system controlling said printer mechanism to output a physical reproduction of said displayed image.

The Examiner relies on the following prior art references to show unpatentability:

Kozuki	US 4,507,689	Mar. 26, 1985
Finelli	US 4,937,676	Jun. 26, 1990
Uekane	US 5,559,554	Sep. 24, 1996 (filed Jul. 19, 1994)
Takahashi	US 5,926,285	Jul. 20, 1999 (filed May 13, 1992)

Claims 8-20, 25, 26, 29, 31-38, 40-43, 45-54, 56-61, 63-68, 70, and 71 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Takahashi in view of Uekane.

Claims 28, 30, 44, 55, 62, and 69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Takahashi in view of Uekane and further in view of Finelli.

Claims 21-24 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Takahashi in view of Uekane and further in view of Kozuki.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUES

(i) Under 35 U.S.C § 103(a), with respect to appealed claims 8-20, 25, 26, 29, 31-38, 40-43, 45-54, 56-61, 63-68, 70, and 71, would one of ordinary skill in the art at the time of the invention have found it obvious to combine Takahashi and Uekane to render the claimed invention unpatentable?

(ii) Under 35 U.S.C § 103(a), with respect to appealed claims 28, 30, 44, 55, 62, and 69, would one of ordinary skill in the art at the time of the invention have found it obvious to modify the combination of Takahashi and Uekane by adding the teachings of Finelli to render the claimed invention unpatentable?

(iii) Under 35 U.S.C § 103(a), with respect to appealed claims 21-24 and 30, would one of ordinary skill in the art at the time of the invention have found it obvious to modify the combination of Takahashi and Uekane by adding the teachings of Kozuki to render the claimed invention unpatentable?

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore, ““there must be some articulated

reasoning with some rational underpinning to support the legal conclusion of obviousness' . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR*, 127 S. Ct. at 1739). “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *KSR*, 127 S. Ct. at 1742.

ANALYSIS

I. The combination of Takahashi and Uekane

Claims 40, 42, 43, 46, 47, 49-54, 57, 58, 60, 61, 64, 65, 67, 68, and 71

With respect to the Examiner’s 35 U.S.C. § 103(a) rejection of appealed independent claims 40, 47, 58, and 65 based on the combination of Takahashi and Uekane, Appellants’ arguments in response assert a failure to set forth a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references.

Appellants' arguments initially focus on the contention (App. Br. 7-10), that, in contrast to the claimed invention, the display device 202 illustrated in Figure 19A of Takahashi is not incorporated within the camera-integrated VTR 211.

We do not find Appellants' arguments to be persuasive. To whatever extent Appellants are suggesting that the Examiner's proposed combination of Takahashi and Uekane must fail since Takahashi does not provide a disclosure of a display incorporated within a camera, we find such contention to be without merit since the Examiner has relied upon Uekane (Figures 7 and 12) for this teaching. Similarly, while Appellants contend that Uekane fails to teach that the disclosed monitor incorporated camera is controllable from an operation system incorporated within the printer housing, it is Takahashi (col. 15, ll. 35-38), not Uekane, that is relied upon for this teaching.

It is apparent from the Examiner's line of reasoning in the Answer that the basis for the obviousness rejection is the combination of Takahashi and Uekane. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F. 2d 413 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F. 2d 1091, 1096 (Fed. Cir. 1986). In addition, we find no error in the Examiner's line of reasoning establishing a basis for the proposed combination of Takahashi and Uekane for all of the reasons articulated by the Examiner at pages 4, 5, and 30 of the Answer.

In view of the above discussion, since the Examiner's prima facie case of obviousness has not been overcome by any convincing arguments from Appellants, we sustain the Examiner's 35 U.S.C. § 103(a) rejection, based on the combination of Takahashi and Uekane, of independent claims 40, 47, 58, and 65 as well as dependent claims 42, 43, 46, 49-54, 57, 60, 61, 64, 67, 68, and 71 not separately argued by Appellants.

Claims 8-17, 20, 25, 26, 29, and 31-38

We also sustain the Examiner's obviousness rejection, based on the combination of Takahashi and Uekane, of independent claim 8, as well as dependent claims 9-17, 20, 25, 26, 29, and 31-38 not separately argued by Appellants. The language of independent claim 8 differs slightly from previously discussed independent claims 40, 47, 58, and 65 in that a removable connection of the camera with respect to the printer housing is set forth.

We find no error in the Examiner's stated position (Ans. 16, 17, 27) that the ordinarily skilled artisan would have recognized and appreciated that the camera-integrated VTR unit 211 in Takahashi, identified as a "camcorder" at column 4, line 37, would be removably connected to the printer housing to enable the camera/VTR unit to function as a portable unit separate from the printer housing. Appellants' arguments (App. Br. 11-13; Reply Br. 2-3) to the contrary notwithstanding, we do not agree that the presence of the data bus 428 in the Figure 20A illustration in Takahashi leads to the conclusion that the camera/VTR 211 connection to the printer

housing 203 is a fixed connection. We further find to be unpersuasive Appellants' contention that the Examiner's rejection must fail because Uekane lacks a disclosure of a printer since it is Takahashi, not Uekane, that is relied upon for a teaching of a printer connected to a camera.

Dependent claims 18, 19, 41, 45, 48, 56, 59, 63, 66, and 70

The Examiner's obviousness rejection of these claims is also sustained. We find no error in the Examiner's finding (Ans. 5, 9, 12, 14, 20, and 21) that Takahashi provides a disclosure of the memory button and picture memory features of these claims. We note that, while Appellants present arguments directed to these claims in the Reply Brief, we have not considered these arguments since no separate arguments for patentability with respect to these claims were presented in the principal Brief. *See Optivus Tech., Inc. v. Ion Beam Applications S.A.*, 469 F.3d 978, 989 (Fed. Cir. 2006) ("[A]n issue not raised by an appellant in its opening brief ... is waived.") (citations and quotation marks omitted).

II. The combination of Takahashi, Uekane, and Finelli

Dependent claims 28, 30, 44, 55, 62, and 69

We also sustain the Examiner's 35 U.S.C. § 103(a) rejection of dependent claims 28, 30, 44, 55, 62, and 69 based on the combination of Takahashi, Uekane, and Finelli. Appellants (App. Br. 10, 11, and 14) have made no separate arguments for patentability of these claims but, rather, rely on arguments previously made with respect to independent

claims 8, 40, 47, 58, and 65, which arguments we found to be unpersuasive for all of the reasons discussed *supra*.

*III. The combination of Takahashi, Uekane, and Kozuki
Dependent claims 21-24 and 30*

As with the previously discussed obviousness rejection that included Finelli in combination with Takahashi and Uekane, Appellants have made no separate arguments for patentability for claims 21-24 and 30 in which the Examiner added Kozuki to Takahashi and Uekane to address the guide rail structure feature of these claims. Appellants rely on arguments made with respect to independent claims 8, 40, 47, 58, and 65 which we found to be unpersuasive and, accordingly, we sustain the Examiner's obviousness rejection of these claims.

CONCLUSION

In summary, we have sustained the Examiner's 35 U.S.C. § 103(a) rejections of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 8-26, 28-38, and 40-71 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (2006).

Appeal 2007-3585
Application 08/610,758

AFFIRMED

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